

### REMARKS

Applicants respectfully request entry of the foregoing and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. § 1.112 and in light of the remarks which follow.

Claims 20-29 are pending in the application.

By the above amendments, Applicants amended Claim 20 to address the claim objection. Because Applicants' amendment does not narrow the scope of Claim 20, the claim should be accorded its full range of equivalents.

First, Applicants thank the Examiner for acknowledging Applicants' Request for Continued Examination (RCE) and withdrawing the finality of the previous Official Action. Applicants also thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. §119 and for indicating that all certified copies of the priority documents have been received.

Applicants also thank the Examiner and Supervisory Examiner Jafar for the courtesies extended to their representative Martin Bruehs during the personal interview conducted on July 24, 2008. In particular, although the Examiner's Interview Summary does not provide a detailed description of all the issues discussed during the personal interview, Applicants were pleased to learn from their representative that the Examiners had agreed to reconsider the outstanding rejection under 35 U.S.C. § 103(a) over *Urbaniak*. In particular, Applicants were pleased to hear that the Examiners would again consider the various features of the claimed process that are neither disclosed nor fairly suggested by *Urbaniak*. Specifically, Applicants understood that the Examiners would reconsider the fact that *Urbaniak* does not disclose or fairly suggest: (1) a continuous process; (2) a process

comprising continuously contacting an alcohol of formula (VIII) in countercurrent with a silane of formula (VII); or (3) stripping of the product of formula (H-Hal) formed, as defined in Claim 20. Applicants also understood that the Examiners agreed that the § 103 rejection would not be maintained unless the Patent Office could cite one or more references to support the position that it would have been obvious to modify the batch process of *Urbaniak* to include each of the claimed features. Indeed, because Applicants understood that the Examiners agreed to conduct a further search to determine if such an additional reference exists and to contact Applicants' representative following the further search, Applicants are surprised that the present Official Action appears to simply restate the same § 103(a) rejection over *Urbaniak*. If the Examiners have conducted such a further search and have found no additional references to support the position that it would have been obvious to modify the batch process of *Urbaniak* to include all of the different features recited in the pending claims of the instant application, Applicants respectfully urge the Examiners to reconsider and withdraw the outstanding § 103(a) rejection over *Urbaniak* for at least the reasons provided below.

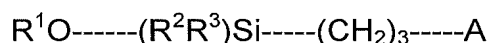
Turning now to the Official Action, Claim 20 stands objected to because the claim includes a typographical error. In order to obviate the objection, Applicants have amended Claim 20 to remove the typographical error.

Applicants respectfully request reconsideration and withdrawal of the objection.

Claims 20-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Urbaniak* (Synthesis and Reactivity in Organic and Metal-organic Chemistry,

Synthesis of Siloxyphosphines, 1988, 18(7), 695 to 703). For at least the reasons that follow, withdrawal of the rejection is in order.

Again, independent Claim 20 defines a continuous process for preparing an organodialkylalkoxysilane of formula (IX):



comprising the steps of:

a) continuously contacting an alcohol of formula (VIII):  $R^1\text{-OH}$  in countercurrent with a silane of formula (VII):  $\text{Hal---}(R^2R^3)Si\text{---}(CH_2)_3\text{---}A$ , in order to carry out the alcoholysis reaction of said silane in order to obtain the silane of formula (IX) and a product of formula  $H\text{-Hal}$ , the operation being carried out with stripping of the product of formula  $H\text{-Hal}$  formed, and

b) recovering the organodialkylalkoxysilane formed in the reactor, in which formulae the symbol Hal represents a halogen atom selected from chlorine, bromine and iodine atoms, the chlorine atom being preferred; the symbols  $R^1$ , which are identical or different, each represent a monovalent hydrocarbon group selected from a linear or branched alkyl radical having 1 to 15 carbon atoms and a linear or branched alkoxyalkyl radical having 2 to 8 carbon atoms; the symbols  $R^2$  and  $R^3$ , which are identical or different, each represent a monovalent hydrocarbon group selected from a linear or branched alkyl radical having 1 to 6 carbon atoms and a phenyl radical; and

A represents a removable group selected alternatively from: a halogen atom Hal belonging to chlorine, bromine and iodine atoms, or a radical  $\text{para-}R^0\text{-C}_6\text{R}_4\text{-SO}_2\text{-O-}$  wherein  $R^0$  is a linear or branched C1-C4 alkyl radical, or a radical  $R^0\text{-}$

SO<sub>2</sub>-O- wherein R<sup>0</sup> is as defined above, or a radical R<sup>0</sup>-CO-O- wherein R<sup>0</sup> is as defined above. (Emphasis added.)

As explained in Applicants' Amendment of November 5, 2007, and again in the personal interview conducted in July of 2008, *Urbaniak* relates to disiloxydiphosphines of a specified type synthesized effectively by phosphination of the corresponding ethoxysimethyl(omega-halogenoalkyl)silanes followed by their hydrolysis. (See, *Urbaniak* at Abstract).

Despite Applicants' prior remarks and the discussion with Applicants' representative during the personal interview on July 24, 2008, the Official Action has again asserted that the instantly claimed process of preparation of organodialkylalkoxysilane by reacting silane compound with an alcohol would have been suggested to one of ordinary skill in view of the teaching of *Urbaniak et al.* (See, Official Action at page 4). Applicants continue to respectfully disagree and are somewhat surprised that the Official Action has simply maintained the rejection after the apparent agreement during the personal interview that the Patent Office would conduct a further search to find evidence (if any exists) to support the position that it would have been obvious to modify the batch process of *Urbaniak* to include the various different features of the claimed continuous process.

Again, a *prima facie* case of obviousness requires that the prior art reference (or references when combined) teach or suggest all the claim features. (See, *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).) It is also necessary that "all words in a claim be considered in judging the patentability of that claim against the prior art." (See, *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496

(C.C.P.A. 1970), and M.P.E.P. § 2143.03.) Applicants submit that these requirements have still not been met.

In particular, Applicants assert yet again that independent Claim 20 includes among the defined combination of features, steps of: (1) continuously contacting an alcohol of formula (VIII) in countercurrent with a silane of formula (VII); (2) stripping of the product of formula H-Hal formed; and (3) recovering the organodialkylalkoxysilane formed in the reactor. Nowhere, however, does *Urbaniak* disclose or fairly suggest a method comprising these particular steps in combination with the other features defined in independent Claim 20. Indeed, the Official Action appears to acknowledge this and Applicants understood that this was also acknowledged during the personal interview in July of 2008. In fact, Applicants understood that the personal interview concluded with the understanding that a further search by the Patent Office was necessary to determine if any evidence could be found to support the position that it would be obvious to modify the batch process of *Urbaniak* to include each of the specific features defined in Claim 20. Although Applicants do not know if the further search was conducted, what is clear is that the Official Action still does not cite any evidence to support the contention that one of ordinary skill would have been motivated at the time of the invention to modify *Urbaniak* to arrive at the claimed process.

Despite Applicants' prior remarks and the discussion during the personal interview regarding the deficiency of the prior art rejection over *Urbaniak*, the Official Action appears to continue to allege that it would have been obvious to one of ordinary skill in the art to simply modify the batch process of *Urbaniak* in several different ways including, for example, (1) making the process of *Urbaniak*

continuous, (2) employing countercurrent, and (3) varying other reaction conditions to arrive at the claimed continuous process. Such a broad and unsupported § 103(a) rejection is not appropriate. The Patent Office bears the burden of establishing *why* one of ordinary skill would have been led to modify the process of *Urbaniak* or combine it with other reference teachings to arrive at the claimed subject matter. The requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art, not from Applicants' disclosure. (See, *Ex parte Nesbit*, 26 U.S.P.Q.2d 1817, 1819 (B.P.A.I. 1992); and *In re Oetiker*, 24 U.S.P.Q. 2d. 1443, 1446 (Fed. Cir. 1992).)

The mere fact that a prior art reference can be modified does not make such a modification obvious without some suggestion that the modification is desirable. (See, *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).) There must be an intrinsic basis in the prior art or some extrinsic factor that would prompt one of ordinary skill to modify the teachings of *Urbaniak*; otherwise, the Patent Office has not met its burden of establishing a *prima facie* case of obviousness. The determination of whether some reason, suggestion or motivation existed for making the combination must be made from the viewpoint of the hypothetical person of ordinary skill in the field of the invention.

In the present case, Applicants continue to submit that no such factors or motivation for modifying the process of *Urbaniak* are presented in the Official Action. Without any evidence to suggest otherwise, Applicants submit that persons of ordinary skill in the art would simply not have had a reason to modify the batch

process of *Urbaniak* in the various ways asserted in the Official Action to arrive at the process defined by Claim 20.

Despite Applicants' best efforts to urge the Patent Office to provide evidence of motivation in *Urbaniak* or elsewhere that would have led one of ordinary skill to have looked at the batch process of *Urbaniak* and modified it to include all the features of the presently pending claims, no further evidence has been provided. Clearly, based on at least the above factors, the motivation for modifying *Urbaniak* to arrive at the claimed process only comes from the teachings of the present specification, which disclose the desirability of the claimed combination of features including the above-specified continuous process steps. The motivation for combining or modifying references, however, cannot be a product of hindsight reconstruction of the claim subject matter based on Applicants' own disclosure.

Here, the Patent Office's continued assertion that it would have been obvious to simply modify *Urbaniak* is improper because *Urbaniak* viewed by itself, and not in retrospect, does not suggest the modification asserted by the Official Action. (See, *In re Shaffer*, 228 F.2d 476, 108 U.S.P.Q. 327 (C.C.P.A. 1956); and *In re Stoll*, 523 F.2d 1392, 187 U.S.P.Q. 481 (C.C.P.A. 1975).) *Urbaniak* fails to provide any motivation for modifying the disclosed batch process and the Official Action has failed to provide any other evidence that would have led one of ordinary skill in the art to modify the *Urbaniak* process to incorporate each of the specific technical features defined in Claim 20.

Again, to the extent that the Official Action is asserting official notice to support the § 103(a) rejection over *Urbaniak*, Applicants continue to respectfully oppose the assertion. Applicants do not agree that the claimed combination of

process steps is of such "notorious character that official notice can be taken." (See, *In re Malcolm*, 129 F.2d 529, 54 U.S.P.Q. 235 (C.C.P.A. 1942).) Accordingly, if the Official Action is relying on official notice to support the rejection, Applicants traverse the assertion and request that the Patent Office conduct the further search discussed during the personal interview of July 2008 and identify one or more references (to the extent they can be found) to support the position being taken. (See, M.P.E.P. § 2144.03.) Otherwise, the rejection should be withdrawn.

Applicants also continue to submit that the Official Action has not established a reasonable expectation of success. That is, beyond looking to *Urbaniak* to determine if it suggests doing what the inventors have done, one must also consider if *Urbaniak* provides the required expectation of succeeding in that endeavor. (See, *In Dow Chem. Co. v. American Cyanamid*, 837 F.2d at 473, 5 U.S.P.Q.2d at 1531 (both the suggestion and the expectation of success must be founded in the prior art, not in Applicants' disclosure). Here, *Urbaniak* provides neither a suggestion nor an expectation of success in doing what the inventors have done (i.e., combining the recited steps to arrive at the claimed continuous process for preparing an organodialkylalkoxysilane of formula (IX) including countercurrent contacting of reactants and stripping of the product H-Hal formed.) Applicants again submit that the Official Action has failed to provide any evidence to indicate that one would have expected to obtain the claimed continuous process (including countercurrent contact and stripping of H-Hal) and its resulting advantages by modifying the batch process of *Urbaniak*, which the Official Action and the Examiners have acknowledged is missing several of the features defined in Claim 20.



For at least these reasons, Claim 20 is patentable over *Urbaniak*. The remaining claims (Claims 21-29) depend, directly or indirectly, from Claim 20 and, therefore, are also patentable over *Urbaniak* for at least the reasons that Claim 20 is patentable. Reconsideration and withdrawal of the § 103(a) rejection of Claims 20-29 are respectfully requested.

Finally, in order to avoid further delay in the prosecution of the instant application, Applicants again respectfully request a personal interview with the Examiners to discuss the outstanding rejection.

From the foregoing, Applicants earnestly solicit further and favorable action in the form of a Notice of Allowance.

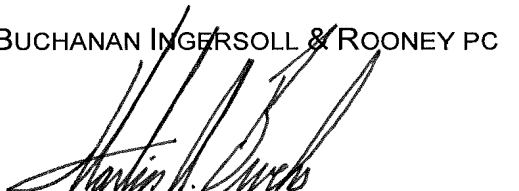
If there are any questions concerning this paper or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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By:



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